REMARKS

Claims 1-17 are all of the claims presently pending in the application. Previously pending claims 1-11 have not been amended by the present Amendment. Claims 12-17 have been added to claim additional features of the invention and to provide more varied protection for the claimed invention.

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fekas et al. (U.S. Patent Application Publication No.: 2002/0005899; hereinafter "Fekas"). Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fekas in view of Hanna et al. (U.S. Patent No. 6,761,308; hereinafter "Hanna"). Claims 2, 5 and 7-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fekas in view of Sato.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1, is directed to an electronic journal preparation system (and method) including <u>a card embossed image pick-up portion for picking up a card embossed image from a bank card when the customer inputs the bank card, and a customer transaction data image processing portion for forming an image regarding customer transaction data</u> (e.g., see Application at page 2, lines 8-19). This feature allows the present invention to provide an electronic journal preparation system (and method) in which the personal history backgrounds are difficult to alter (see Application at page 2, lines 5-7).

II. THE PRIOR ART REFERENCES

A. The Fekas Reference

The Examiner alleges that Fekas teaches the claimed invention of claims 1 and 4.

Applicant respectfully submits, however, that there are features of the claimed invention that

are not taught or suggested by Fekas.

That is, Fekas does not teach or suggest "*a card embossed image pick-up portion for*

picking up a card embossed image from a bank card when said customer inputs said bank

card; a customer transaction data image processing portion for forming an image regarding

customer transaction data", as recited in claim 1 and somewhat similarly recited in claim 4.

The Examiner attempts to rely on paragraphs [0019], [0020], [0021] and [0023] of

Fekas to support her allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in these paragraphs (nor anywhere else for that matter) does Fekas

teach or suggest <u>a card embossed image pick-up portion for picking up a card embossed</u>

<u>image from a **bank card** when the customer **inputs the bank card**, and a customer</u>

<u>transaction data image processing portion for forming an image regarding customer</u>

<u>transaction data</u>. Indeed, the Examiner has clearly mischaracterized the teachings of Fekas.

Fekas merely teaches an identification recording system where a first camera captures

a video of an <u>identification card</u>, a second camera captures a video portrait image of a person

and a third camera captures a profile video image of a person (see Fekas at paragraph

[0019]). Fekas, however, is <u>not</u> directed to a **bank** card or a customer transaction conducted

using the **bank** card. Therefore, Fekas does not teach or suggest <u>a card embossed image</u>

<u>pick-up portion for picking up a card embossed image from a **bank card** when the customer</u>

<u>inputs the bank card</u>.

Furthermore, Fekas does not teach or suggest <u>a customer transaction data image</u>

<u>processing portion for forming an image regarding customer transaction data</u>. Indeed, there

is no customer transaction created in Fekas. Fekas is merely directed to an identification

system that captures a video image of a person and a video image of an <u>identification</u> card.

Therefore, Applicant submits that there are features of the claimed invention that are not taught or suggested by Fekas. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B.   The Hanna Reference

The Examiner alleges that Hanna would have been combined with Fekas to form the claimed invention of claims 3 and 6. Applicant submits, however, that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Applicant submit that these references would not have been combined as alleged by the Examiner. That is, the Examiner can point to <u>no</u> motivation or suggestion in the prior art references to justify such a combination. Fekas and Hanna are each directed to different problems and different means for solving those problems.

Specifically, Fekas is directed to <u>an identification recording system including an identification document video camera, a portrait camera and a profile camera</u>, whereas Hanna is directed to a <u>banking apparatus that dispenses and receives currency in the form of notes and coins</u>. One of ordinary skill in the art would not refer to a reference directed to a banking apparatus that dispenses notes and coins to solve the problems of the system in Fekas. Therefore, these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, <u>absent impermissible hindsight</u>.

Moreover, neither Fekas nor Hanna, <u>nor any combination thereof</u>, teaches or suggests an electronic journal preparation system including "*a card embossed image pick-up portion for picking up a card embossed image from a bank card when said customer inputs said bank card; a customer transaction data image processing portion for forming an image regarding*

customer transaction data", as recited in claim 1 and somewhat similarly recited in claim 4.

As detailed above in section A, Fekas fails to teach or suggest these features of the claimed invention. Furthermore, Applicant submits that Hanna fails to make up the deficiencies of Fekas.

Indeed, the Examiner merely attempts to rely on Hanna as allegedly suggesting inserting a watermark into customer transaction data. The Examiner relies on column 33, lines 44-55 of Hanna to support her allegations.

Nowhere, however, in this passage (nor anywhere else for that matter) does Hanna teach or suggest <u>a card embossed image pick-up portion for picking up a card embossed image from a **bank card** when the customer **inputs the bank card**, and a customer transaction data image processing portion for forming an image regarding customer transaction data</u>. Indeed, the Examiner has <u>not</u> even alleged that Hanna teaches or suggests this recited feature.

Thus, Hanna fails to make up deficiencies of Fekas.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw these rejections.

C.   The Sato Reference

The Examiner alleges that Sato would have been combined with Fekas to teach the claimed invention of claims 2, 5 and 7- 11. Applicant submits, however, that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

That is, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be

met. First, there must be some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings." (see M.P.E.P. § 2142; emphasis added by

Applicant). The Examiner has failed to provide a proper motivation for combining the

teachings of Sato with Fekas.

Indeed, with respect to claim 2, the Examiner alleges that, with respect to the

teachings in Fekas of adding character data to a header portion "[a]t the time of invention, it

would have been obvious to a person of ordinary skill in the art to combine the teachings of

Sato with Fekas. The motivation for doing so is to know the dealings conducted by the

automation corner as suggested by Sato" (see Office Action dated January 31, 2007 at page

4). The Examiner, however, is clearly incorrect.

That is, there would be no motivation to provide character data in header portion of

the image created in Fekas because Fekas does not teach or suggest capturing or creating

character data. Indeed, Fekas merely teaches that a first camera captures a video of an

identification card, a second camera captures a video portrait image of a person and a third

camera captures a profile video image of a person. A composite image of the three captured

images is then created (see Fekas at paragraphs [0019] and [0023]). All of the desired images

are already included in the composite image. There is no further captured data that would be

desired as a heading in Fekas.

Therefore, with respect to the Examiner's allegations regarding claim 2, Applicant

submits that one of ordinary skill in the art would not have been motivated to combine the

heading of Sato in the device of Fekas.

Furthermore, with respect to claims 7, 10 and 11, Applicant submits that the

Examiner has failed to establish a *prima facie* case of obviousness.

The initial burden lies with the Examiner to establish a *prima facie* case of obviousness. As explained above, this requires the Examiner to provide a motivation for combining the features of one reference with the teachings of another reference. In this case, the Examiner must provide a motivation for combining each of the features that she is relying on Sato as providing with the system described in Fekas.

With respect to claims 7, 10 and 11 the Examiner has not provided any motivation or suggestion to combine the features of Sato with the system of Fekas. It appears that the Examiner is relying upon the alleged motivation provided with respect to claim 2 for also combining the features of claims 7, 10 and 11 with Fekas. This, however, is clearly inappropriate.

That is, even assuming that the Examiner's alleged motivation for combining the header of Sato with the system of Fekas is adequate to establish a *prima facie* case of obviousness with respect to claim 2 (which Applicant traversed above), the alleged motivation would only apply to the header of Sato, and not each and every feature taught by Sato.

Indeed, if the Examiner wishes to combine the data table, the index and the CTF of Sato with the teachings of Fekas, the Examiner must provide a motivation for combining these different features with the system of Fekas.

Therefore, at least with respect to claims 7, 10 and 11 the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, with respect to claims 10 and 11, Applicant submits that one of ordinary skill in the art would not have been motivated to include a data table or data index in the system of Fekas, as alleged by the Examiner.

Indeed, as explained above, Fekas merely teaches that a first camera captures a video

of an <u>identification card</u>, a second camera captures a video portrait image of a person and a

third camera captures a profile video image of a person. <u>Fekas does not include data that</u>

<u>could be put into a table or an index</u>.

Moreover, neither Fekas nor Sato, <u>nor any combination thereof</u>, teaches or suggests

an electronic journal preparation system including "*a card embossed image pick-up portion*

for picking up a card embossed image from a bank card when said customer inputs said bank

card; a customer transaction data image processing portion for forming an image regarding

customer transaction data", as recited in claim 1 and somewhat similarly recited in claim 4.

As detailed above in section A, Fekas fails to teach or suggest these features of the

claimed invention. Furthermore, Applicant submits that Sato fails to make up the

deficiencies of Fekas.

That is, nowhere does Sato teach or suggest <u>a card embossed image pick-up portion</u>

<u>for picking up a card embossed image from a **bank card**</u> when the customer **inputs the bank**

card, <u>and a customer transaction data image processing portion for forming an image</u>

<u>regarding customer transaction data</u>. Indeed, the Examiner has <u>not</u> even alleged that Sato

teaches or suggests this recited feature.

Thus, Sato fails to make up deficiencies of Fekas.

Therefore, Applicant submits that these references, even if combined, would not teach

or suggest each and every feature of the claimed invention. Therefore, the Examiner is

respectfully requested to withdraw these rejections.

III.   NEW CLAIMS

New claims 12-17 have been added to claim additional features of the invention and

to provide more varied protection for the claimed invention. These claims are independently

patentable because of the novel and nonobvious features recited therein.

Applicant submits that new claims 12-17 are patentable over any combination of the

applied references at least based on analogous reasons to those set forth above with respect to

claims 1-11.

IV.   FORMAL MATTERS AND CONCLUSION

With respect to the Information Disclosure Statement (IDS) filed on November 22,

2002, the Examiner is respectfully requested to consider <u>each of the references</u> cited therein.

Specifically, on August 16, 2005 the Examiner considered the IDS, however, the Examiner

did not consider and initial JP 4-8872. Indeed, the Examiner erroneously crossed-out this

reference on the Form PTO-1449 (presumably because a translation was not provided for this

reference).

However, the IDS filed on November 22, 2002 **clearly stated** that as a concise

statement of relevance, a translation of a portion of an official action, in which the above

reference was cited, was included with the IDS. Accordingly, the Examiner <u>must</u> consider

this reference.

Therefore, Applicant requests the Examiner to consider <u>each of the references</u> cited in

the IDS filed on November 22, 2002 and to provide Applicant with a new initialed copy of

the Form PTO-1449 indicated that <u>each of the references</u> has been considered.

In view of the foregoing, Applicant submits that claims 1-17, all of the claims

presently pending in the application, are patentably distinct over the prior art of record and

are in condition for allowance. The Examiner is respectfully requested to pass the above

application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,

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the Examiner is requested to contact the undersigned at the local telephone number listed

below to discuss any other changes deemed necessary in a <u>telephonic or personal interview</u>.

   The Commissioner is hereby authorized to charge any deficiency in fees or to credit

any overpayment in fees to Attorney's Deposit Account No. 50-0481.

                                        Respectfully Submitted,

Date: April 30, 2007

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